



FOLEY AND LARDNER  
3000 K STREET NW SUITE 500  
P O BOX 25696  
WASHINGTON DC 20007-8696

**COPY MAILED**

**APR 24 2003**

**OFFICE OF PETITIONS**

In re Application of  
Benoit, et al.  
Application No. 09/240,675  
Filed: 2 February, 1999  
Attorney Docket No. 017283-0123

ON PETITION

This is a decision on the petition 1 August, 2002, under 37 C.F.R. §1.183<sup>1</sup> requesting waiver/suspension of the provisions 37 C.F.R. §1.52 (which Petitioner nonetheless contends does not apply<sup>2</sup>) and §1.67<sup>3</sup> (which Petitioner contends does).

<sup>1</sup> The regulations at 37 C.F.R. §1.183 provide:

**§1.183. Suspension of the rules.**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §1.17(h).  
[47 Fed. Reg. 41278, Sept. 17, 1982, effective Oct. 1, 1982]

<sup>2</sup> Petitioner asserts that the regulations at 37 C.F.R. §1.52 are directed to papers other than the oath or declaration. The regulations at §1.17(h) provide:

\*\*\*

(c)(1) Any interlineation, erasure, cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to §1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67. In either situation, a substitute specification (§1.125) is required if the application papers do not comply with paragraphs (a) and (b) of this section. (Emphasis supplied).

\*\*\*

<sup>3</sup> The regulations at 37 C.F.R. §1.67 provide:

**§1.67 Supplemental oath or declaration.**

(a) The Office may require, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§§ 1.42, 1.43, or § 1.47) may be corrected with a supplemental oath or declaration signed by all the inventors or applicants.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§§ 1.42, 1.43 or § 1.47) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(c) (e.g., to correct the omission of a mailing address of an inventor) in an oath or declaration may be corrected with an application data sheet in accordance with § 1.76.

(4) Submission of a supplemental oath or declaration or an application data sheet (§ 1.76), as opposed to who must sign the supplemental oath or declaration or an application data sheet is governed by § 1.33(a)(2) and paragraph (b) of this section.

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed when a claim is presented for matter originally shown or

The Office regrets the delay in addressing this matter.

For the reasons set forth below, the petition is **GRANTED**.

### BACKGROUND

The record indicates that:

- in her Office action of 31 January, 2001, the Examiner objected to the oath or declaration filed with the application, and required the Petitioner to submit a supplemental oath or declaration pursuant to 37 C.F.R. §1.67(a) due to defects in the original oath or declaration, to wit: [n]on-initialed and/or non-dated alterations have been made to the oath or declaration[,]" and the Examiner further cited 37 C.F.R. §1.52;
- Petitioner filed a reply (with extension of time) filed on 23 July, 2001;
- in her Office action of 7 August, 2001, the Examiner maintained the objection;
- Petitioner filed evidence of an unsuccessful attempt to contact the inventors in the reply (with request for continued examination and request for extension of time) on 7 December, 2001;
- in her Office action of 1 February, 2002, the Examiner again maintained the objection;
- Petitioner filed the instant petition on 1 August, 2002.

### LAW AND ANALYSIS

Applications filed under 35 U.S.C. §111(a) require of applicants an oath, and impose upon applicants and other individuals substantively involved with the preparation and/or prosecution of the application have a duty of disclosure Office as to information which material to patentability.<sup>4</sup>

---

described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with §1.53(f) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper situations, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

(c)[Reserved]

[48 FR 2711, Jan. 20, 1983, effective Feb. 27, 1983; para. (c) added, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised and para. (c) removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

<sup>4</sup> See: 35 U.S.C. §111(a), §115 and §371(a); see also: 37 C.F.R. §1.56.

The regulations at 37 C.F.R. §1.67 provide procedures for requiring and submitting a supplemental oath or declaration in advancement of the statutory requirements.

Petitioner alleges facts, and provides documentation in support thereof, which indicate that despite diligent effort Petitioner is unable to satisfy the requirements of 37 C.F.R. §1.67.

Thus--Petitioner's assertion to the contrary notwithstanding--a waiver of 37 C.F.R. §1.67 is required.

Petitioner having carried the burden of proof, the request for a waiver under 37 C.F.R. §1.183 of the requirements of 37 C.F.R. §1.67 hereby is **granted**.

This application is being forwarded to Technology Center 1600 for further processing.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read 'J. Gillon', with a stylized flourish at the end.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions